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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,298	08/08/2001	Vincent Bryan	46739/262600	3319
27683	7590	01/03/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			PHILOGENE, PEDRO	
			ART UNIT	PAPER NUMBER

3733

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/924,298		BRYAN ET AL.	
	Examiner		Art Unit	
	Pedro Philogene		3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44, 56-61, 66, 67, 70, 71, 74-76, 81-96, 101-103, 106-110 and 112-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-44, 66, 67, 70, 71, 74-76, 86-92 and 114-119 is/are allowed.
- 6) ☒ Claim(s) 56-61, 81-85, 93-96, 101-103, 106-110, 112-113 and 120-122 is/are rejected.
- 7) ☒ Claim(s) 90 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3733

Election/Restrictions

Applicant's election with traverse of Species I in the reply filed on 9/27/05 is acknowledged. The traversal is on the ground(s) that claims 1, 4, 16, 21, 56, 59, 74, 81, 85,86,93-96,101,103,106107,108,110,112 and 114 are generic. This is found to be persuasive because all of the FIGS are plan view or sectional view of the one embodiment of the invention under going translation or lateral bending. The Election/Restriction of the claims is hereby vacated.

Allowable Subject Matter

The indicated allowability of claims 56-61,81-85,93-96,101-103,106-113, is withdrawn in view of the newly discovered reference(s) to Bryan et al and/or Zdeblick et al.. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 56-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Zdeblick et al. (6,402,785).

With respect to claim 56, Zdeblick et al disclose a bone joint implant comprising a central body positioned between two shells (52,54), wherein the central body (16,56,

Art Unit: 3733

116, 156) has an upper and lower contact surface, wherein an upper shoulder is recessed into a portion of the perimeter of the upper contact surface and a lower shoulder is recessed into a portion of the perimeter of the lower contact surface; as best seen in FIGS.44,45.

With respect to claims 57,58, Zdeblick et al disclose all the limitations; as best seen in FIGS. 16, 25.

With respect to claim 59, Zdeblick et al disclose a bone joint implant comprising an encapsulated body having an upper and lower contact surface, wherein the an upper shoulder extends around a portion of the perimeter of the upper contact surface and a lower shoulder extends around a portion of the perimeter of the lower contact surface; as best seen in FIG.25

With respect to claims 60, 61, Zdeblick et al disclose all the limitations; as best seen in FIG.16.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 81-82,84,85,93-96,101-103,106,120-122 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryan et al. (5,674,296).

With respect to claims 81, 85, Bryan et al disclose a bone joint implant comprising a central body (20) positioned between two shells, wherein at least one shell has a first edge that includes a radial stop extending generally axially from a portion thereof, wherein the first edge has an outer edge has an outer circumferential groove therein; as best seen in FIGS.13, 14, and as set forth in column 4, lines 53-67, column 5, lines 1-4.

With respect to claim 82, 84, Bryan et al discloses all the limitations; as best seen in FIGS.13, 14.

With respect to claims 93-96, Bryan et al discloses a central body impregnated with hardening substance or a surface lubricity increasing material; as set forth in column 3, lines 65-67, column 4, lines 1-3.

With respect to claims 101-103,106, 120-122, Bryan et al disclose a motion-preserving bone joint implant comprising a central body positioned and articulable between two shells, the central body having a resilient, deformable portion and coating thereon wherein the resilient , deformable portion allows motion in the joint implant and the coating material has a different hardness from the resilient , deformable portion; as set forth in column 3, lines 50-67, column 4, lines 1-30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 107-110,112-113, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al. (5,674,296).

With respect to claims 107-110, 112-113; it is noted that Bryan et al disclose all the limitations, except for polymer coating, the thickness of the coating or whether the material is the same or different than the central body, as claimed by applicant.

However, it would have been obvious to one having ordinary skill in the art at the time

Art Unit: 3733

the invention was made to use any preferred material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. As to the thickness of the coating , it would have been obvious to one having ordinary skill in the art at the time the invention was made to to reach the optimum value of 1 to 5 mil for the coating, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim Objections

Claim 90 is objected to because of the following informalities: in claim the word – claim—should be inserted before “89”. Appropriate correction is required.

Allowable Subject Matter

Claim 83 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-44, 66-67,70-71,74-76,86-92,114-119, are allowed.

Response to Amendment

Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3733

5,674,294	10-1997	Bainville et al
6,582,466	6-2003	Gauchet

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
December 27, 2005



PEDRO PHILOGENE
PATENT EXAMINER